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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/103,262	06/23/1998	PHILLIP W. BERMAN	P0633D2C2	2802

22798 7590 09/09/2003

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EXAMINER

BUDENS, ROBERT D

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 09/09/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/103,262

Applicant(s)

BERMAN ET AL.

Examiner

R. Budens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 19-23 and 26-30 are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- ☐ Interview Summary (PTO-413) Paper No(s) ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Examiner acknowledges Applicant's preliminary amendment to the first page of the specification updating continuing data. If necessary, the status of related applications should be updated to ensure a complete file record. Furthermore, Applicant is required to request a corrected filing receipt setting forth the continuation data and the relationship of the parent applications to the instant application to properly complete the file wrapper.

Examiner acknowledges Applicant's preliminary amendment to the specification updating the ATCC Designations and Dates of Deposit.

Finally, Examiner acknowledges Applicant's preliminary amendment to the claims, which amends claims 19-21 and adds new claims 26-30.

The status of the claims is as follows: Claims 19-23, and 26-30 are currently pending before the Office.

Election/Restrictions

Pursuant to 35 USC 121, Examiner required Applicant to restrict the present application to one of the following inventions:

- I. Claims 1-7 and 24-25, drawn to methods of treating HIV infection, classified in Class 424, subclass 208.1.
- II. Claims 8-14, drawn to HIV env preparations and vaccines, classified in Class 424, subclass 208.1 and 530, subclass 395.
- III. Claims 15-16, drawn to methods of producing HIV proteins, classified in Class 530, subclass 413.
- IV. Claims 17-18, drawn to recombinant DNA methods for making HIV proteins, classified in Class 435, subclass 69.1.
- V. Claims 19-23, drawn to monoclonal antibodies specific for HIV env, compositions and method of use, classified in Class 424, subclass 148.1.

Additionally, upon election of Group V, Examiner required Applicant to further restrict the present application by electing a single antibody species from within Group V. See Office Action Paper No. 4, dated September 10, 1998.

Applicant's election without traverse of Group V claims 19-23 in Paper No. 6, dated December 14, 1998, is acknowledged. More specifically, Applicant elects species 6E10 in Paper No. 12, dated September 20, 1999.

However, after preliminary amendment to Group V claims, Applicant has still included subject matter directed to nonelected, and presumably, patentably distinct species. Applicant is advised that compliance with this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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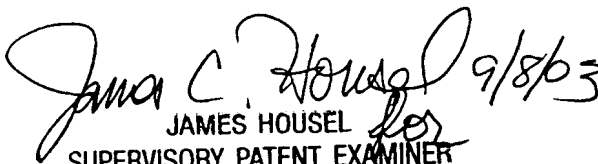
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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 1-18, and 24-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Budens whose telephone number is 703-306-5825. The examiner can normally be reached on Tuesday - Friday 9-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5825.

 9/8/03
JAMES HOUSEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Robert D. Budens
Primary Examiner
Art Unit 1648

R. Budens:djv
September 4, 2003

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